



Attorney Docket No.:
SP01-302

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: G. Cook et al.

Serial No: 10/035,659

Filing Date: October 26, 2001

Title: Direct Bonding of Glass Articles
for Drawing

Group Art Unit: 1731

Examiner: HOFFMANN, John M

RESPONSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO THE EXAMINER'S RESTRICTON REQUIRMENT

In the Office action dated April 5, 2004 in the above-captioned application, the Examiner has issued a Restriction Requirement identifying the following groups of claims as being drawn to potentially distinctive inventions:

Group I: Claims 1-31, drawn to a method of making a glass article, classified in class 65, subclass 406;

Group II: Claim 32, drawn to an optical fiber, classified in class 385, subclass 123.

As a formality, Applicants hereby provisionally elect Group I claims, i.e., claims 1-31, for further prosecution, with traverse.

The Examiner asserted that these inventions are distinct from one another because inventions I and II are related as process of making and product made. The Examiner asserted that the in the instant case, "the product can be made by a materially different process such as one where no performs are bonded together."

Applicants respectfully traverse the Examiner's Restriction Requirement on the grounds that the proposed inventions are inextricably intertwined, and prosecution of the proposed groups of claims together would be most effective for the Office. In order to conduct a comprehensive search regarding any one of the groups, including the groups provisionally elected above, it would inherently necessary to review the same pertinent fields and classes of prior art relating to the other groups. Moreover, the important questions of patentability and claim interpretation are likely to be based on substantially similar issues and evaluations for each group of claims, and

would require consideration of the same prior art, and combined prosecution is therefore less likely to result in inconsistent or conflicting file histories.

As such, Applicants respectfully request that the Examiner withdraw the Restriction Requirement in the next subsequent Office action, and continue examination of Groups I-II, claims 1-32 together with one another.

Contingent upon the Examiner's refusal to withdraw the restriction requirement, Applicants submit that the Group I, claims 1-31 have been elected above, for further prosecution.

The Examiner further asserted that claims 1, 13, 14, 22 and 32 are generic claims to a plurality of disclosed patentably distinct species comprising the following species:

1. comprising A1, B1 and C1;
2. comprising A1, B1 and C2;
3. comprising A1, B2 and C1;
4. comprising A1, B2 and C2;
5. comprising A2, B1 and C1;
6. comprising A2, B1 and C2;
7. comprising A2, B2 and C1;
8. comprising A2, B2 and C1;
9. comprising A3, B1 and C1;
10. comprising A3, B1 and C2;
11. comprising A3, B2 and C1;
12. comprising A3, B2 and C2;
13. comprising A4, B1 and C1;
14. comprising A4, B1 and C2;
15. comprising A4, B2 and C1;
16. comprising A4, B2 and C2;
17. comprising A5, B1 and C1;
18. comprising A5, B1 and C2;
19. comprising A5, B2 and C1;
20. comprising A5, B2 and C2;
21. comprising A6, B1 and C1;
22. comprising A6, B1 and C2;
23. comprising A6, B2 and C1;
24. comprising A6, B2 and C2;

wherein A1 = bonding by wringing; A2 = bonding by chemical bonding; A3 = bonding by vacuum bonding; A4 = bonding by hydrogen bonding; A5 = bonding by hydrophilic bonding; A6 = bonding by covalent bonding; B1 = end to end bonding; B2 = side by side bonding; C1 = no acid treatment; and C2 = acid treatment.

As a formality, Applicants hereby elect the species comprising A6, B1 and C2, i.e., the species comprising "bonding by covalent bonding," "end to end bonding" and "acid treatment."

Applicants respectfully traverse this species election requirement.

Applicants respectfully submit that this species election requirement is not reasonable. The MPEP provides that a species election is only reasonable when there the claims contain more than a reasonable number of species. The distinction drawn between B1 and B2, and C1 and C2, each resulting in only two scenarios, are unreasonable reasons for imposing the species election requirement.

In view of the elections made in response to the restriction requirement and the species election requirement, Applicant hereby elect claims 1-31 for further prosecution.

Applicants believe that no extension of time is necessary to make this Response timely. Should Applicants be in error, Applicants respectfully request that the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Response timely, and hereby authorize the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 03-3325.

The undersigned attorney is granted limited recognition by the Office of Discipline and Enrollment of the USPTO to practice before the USPTO in capacity as an employee of Corning Incorporated. A copy of the document granting such limited recognition either has been previously submitted or is submitted herewith.

Please direct any questions or comments to the undersigned at (607) 248-1253.

Respectfully submitted,

Date: May 5, 2004

Date of Deposit: 5-5-04

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date indicated above with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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